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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,171	04/09/2001	George M. Brookner	13668-960002	9225
23838 7590 02/14/2007 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			EXAMINER ROBINSON BOYCE, AKIBA K	
			ART UNIT 3628	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			02/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/829,171

Applicant(s)

BROOKNER ET AL.

Examiner

Akiba K. Robinson-Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Due to communications filed 11/21/06, the following is a final office action. Claims 1, 16 and 20 have been amended. Claim 23 has been cancelled. Claims 1-22 are pending in this application and have been examined on the merits. The previous rejection has been maintained, with the exception of placing the 35 U.S.C. 103 rejection of claim 14 under the 35 U.S.C. 103 heading instead of the 35 U.S.C. 102 heading, in order to clarify an minor error made by the examiner in the previous action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-8, 15, 16-18, and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Eddy et al (US 5,812,400).

As Per Claim 1, Eddy et al discloses:

interfacing said device with a system, [{col.2, lines 15-17}, metering device (metering, postage meter) communications (interface) between the user and a remote data center (system);

immediately transmitting from said device to the system a present location of said device, [{col.2, lines 48-55 }, meter device establish communication with data center and device communicating location data, in this particular case, Eddy et al teaches that the user operating the value metering device causes the value metering device to accept the physical location data for storage in the value metering device. Although the user has access to the device, the actual acceptance of the location from the value metering device occurs immediately upon validation of identifying data. Once the identifying data is validated, the user does not have to interrupt processing of transmission of location data, the user only must only communicate the identifying data in the beginning].

comparing in a database associated with said system the present location of said device with a previously stored location, [{col. 11, lines 50-53}, the location information stored in the card is checked against the location information stored in memory];

transmitting to said device from said system an authorization to utilize said funds only if the present location is within a predetermined region associated with said previously stored location, [{col. 11, lines 29-34}, correspondence between two stored location].

As per claim 2, Eddy et al discloses:

wherein said authorization is transmitted only if the present location matches the previously stored location, [{col. 11, lines 29-34}, correspondence between two stored location].

As per claim 3, Eddy et al discloses:

wherein said device (postage meter) is licensed for use at said previously stored location, and if the comparing indicates that the device is not in the predetermined region, the system issues a new license for a region associated with the present location of said device, [{col. 1 O, lines 58-57}, electronic postage licensing to be operated in a location].

As per claim 4, Eddy et al discloses:

communicating from the system to the device, data associated with the present location, [{col.2, lines 40-47}, postage meter communicates the user and the data center (system) and {col.2, lines 45-47}, locations data for storage metering device if location data is correct, this suggest that a comparison of location is being conducted in order for location to be determined].

As per claims 5, 15, Eddy et al discloses:

wherein said device is a postal security device, (postage meter device) and said data includes at least one of zip code, city and state information, [{col. 13, lines 37-40}, zip code updates by the data center].

As per claim 6, Eddy et al discloses:

powering up said device, the method being conducted when said device is powered up, (co1.8, lines 22-31), various power provided to the computer and postage meter system (device).

As per claim 7, Eddy et al discloses:

transmitting is done when said device establishes a contact with said system, [col.8, lines 8-10}, communication with the metering systems.

As per claim 8, Eddy et al discloses:

contact with said system is terminated after the location of said device is determined, [co1.2, lines 40-47}, accept location data for storage in value metering device if location data is correct].

As per claim 16, Eddy et al discloses:

a memory for storing value of said funds, {co1.2, lines 48-57}, value metering device, storage for funds];

apparatus associated with said device for determining the present location of said device, [co1.2, lines 48-57}; and

a communication port for providing communication between said device and a system, said device immediately communicating said present location to said system via said port, [co1.2, lines 14-15}, establish communication between user and data center, in this particular case, Eddy et al teaches that the user operating the value metering device causes the value metering device to accept the physical location data for storage in the value metering device. Although the user has access to the device, the actual acceptance of the location from the value metering device occurs immediately upon validation of identifying data. Once the identifying data is validated, the user does not have to interrupt processing of transmission of location data, the user only must only communicate the identifying data in the beginning].

As per claim 17, Eddy et al discloses:

apparatus for receiving from said system an authorization to access said funds, if said location is within a predetermined region, [(co1.11, lines 29-34}, correspondence between stored location after authentication processing may proceed].

As per claim 18, Eddy et al discloses:

apparatus provides access to said funds if said location corresponds to a predetermined location, [{col.2, lines 40-47}, physical location data for storage in said value metering device location is correct].

As per claim 20, Eddy et al discloses:

a device for the secure storage of funds, including: a memory for storing value of said funds, apparatus associated with said device for determining a location of said device, [(co1.2, lines 48-57), value metering device, storage for funds];

apparatus associated with said device for determining the present location of said device, [co1.2, lines 48-57];

a communication port for providing communication between said device and a system, said device immediately communicating said location to said system via said port, (col.2, lines 48-51), communicates to the value metering device, in this particular case, Eddy et al teaches that the user operating the value metering device causes the value metering device to accept the physical location data for storage in the value metering device. Although the user has access to the device, the actual acceptance of the location from the value metering device occurs immediately upon validation of identifying data. Once the identifying data is validated, the user does not have to

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interrupt processing of transmission of location data, the user only must only communicate the identifying data in the beginning];

the system having a database for storing, for each device, a predetermined location, (col.2, lines 48-55) for storage in said value metering device);

apparatus in said system for providing an authorization to said device to dispense funds only if said present location is within a region associated with said predetermined location, (col.11, lines 29-34).

As per claim 21, Eddy discloses:

provides said authorization only if said present location matches said previously stored location, (col.2, lines 40-47), physical location data for storage in said value metering device location is correct].

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-14, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al (US 5,812,400), as applied to claim 1 above, and further in view of Gravell et al (US 5,943,658).

As per claim 9, Eddy teaches a method comprising: Locating a postage meter but Eddy's doesn't explicitly mention the following:

wherein if said contact is made by telephone, the location of said device is determined by using caller identification and if said contact is not made by telephone, other means are used to determine the location.

However Gravell teaches contact is made by telephone, the location of said device is determined by using caller identification and if said contact is not made by telephone, other means are used to determine the location, [{Col.2, lines 38-49}, the caller ID feature the location of postage meter can be determined].

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include caller identification in conjunction with locating a postage meter with the system taught by Gravell et al with the motivation of using a telephone incorporated with caller identification to locate a postage device.

As per claims 10 and 12, Eddy teaches a method comprising: Locating a postage meter but doesn't explicitly mention the following:

contact is made using a network, the location of said device is determined by obtaining a network address of said device.

However Gravell teaches contact is made using a network, the location of said device is determined by obtaining a network address of said device in column 1, lines 58-66, postage meters are moved to any location by means of communicating such as networks, internet and the like]. This suggests that a network can determine the location of the device.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the location of the device in conjunction with obtaining a

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network to locate the device within the system taught by Gravell with the motivation of locating a device with a network.

As per claim 11, Eddy teaches a method comprising: Locating a postage meter but doesn't explicitly disclose:

contact is made using the Internet, the location of said device is determined by using Internet service provider location identification.

However Gravell teaches contact is made using the internet, the location of said device is determined by using internet service provider location identification in column 1, lines 58-66, postage meters are moved to any location by means of communicating such as networks, internet and the like]. This suggests that a network can determine the location of the device.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the location of the device in conjunction with obtaining a network to locate the device within the system taught by Gravell with the motivation of locating a device with a network.

As per claim 13, Eddy teaches a method comprising: Locating a postage meter but doesn't explicitly disclose:

device is associated with a position determining apparatus for determining its location, said device providing to said system its location as determined by said position determining apparatus.

However Gravell teaches device is associated with a position determining apparatus for determining its location, said device providing to said system its location

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as determined by said position determining apparatus in col.2, lines 40-47 that accept location data for storage in value metering device if location data is correct].

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the position for determining the location of the device in within the system taught by Gravell et al with the motivation of determining the location of the device.

As per claim 14, Eddy teaches a method comprising: Locating a postage meter but doesn't explicitly disclose: position locating apparatus is a global positioning system receiver.

However Eddy teaches in column 2, lines 48-57 that the device communicates to the data center. This suggests that an actual GPS system is not used but a locator system is capable of functioning in the same manner as the GPS.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include a device that is associated with a GPS system in conjunction with a locator system within the system taught by Eddy's with motivation if locating a device using Global Positioning System to operate the system more efficiently.

As per claims 19 and 22, Eddy teaches a method comprising: Locating a postage meter but doesn't explicitly disclose: apparatus for encrypting and digitally signing, or digitally signing said communication.

However Eddy teaches that identifying the dispense postage and location identifier which indicates the amount while being verified by the postal authority to

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authenticate the authenticity of the transaction in column 11, lines 19-45. In addition, while Eddy doesn't explicitly mention digitally signing. Digitally signing relates to verification and verification is met when the postal authority examines the transaction.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include a device that is capable of digitally signing said communication for the reasons of distributing funds or assessing funds by via of postal authority authorization to make the system more efficient for operation.

Response to Arguments

6. Applicant's arguments filed 11/21/06 have been fully considered but they are not persuasive.

Applicant's main argument is that in the present invention, the local post office is immediately notified of a PSD (Postal Security Device), which is outside its licensed area, and done automatically without any user or customer action. Applicant argues that in contradiction, Eddy requires action on the part of the user or customer, and that there is no disclosure of immediately doing the present location notification. However, independent claims 1, 16, and 20 recite "immediately transmitting from said device to the system a present location of said device", and "immediately communicating said present location to said system", which is what Eddy et al discloses. It is true that Eddy et al teaches that the user operating the value metering device causes the value metering device to accept the physical location data for storage in the value metering device. However, although the user has access to the device, the actual acceptance of the location from the value metering device occurs immediately upon validation of

identifying data. Once the identifying data is validated, the user does not have to interrupt processing of transmission of location data, the user only must only communicate the identifying data in the beginning.

Similarly, as per claims 9-13, 19 and 22, applicant argues that Gravell fails to disclose the immediate notification of the present location concept. However, as in Eddy et al, Gravell teaches that the user is only involved in the beginning. There is no user action needed past the initiation of the phone call. Furthermore, the Gravell reference was only used to teach the deficiencies of Eddy et al. As disclosed above in the preceding paragraph, transmission occurs immediately in Eddy et al since the actual acceptance of the location from the value metering device occurs immediately upon validation of identifying data. Therefore, the combination of Eddy et al and Gravell discloses immediate transmission.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 9am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A handwritten signature in cursive script, appearing to read 'Akiba K Robinson-Boyce'.

A. R. B.
February 8, 2007